

Docket No.: 58977-02

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

JACKSON, JAMES P., et al.

Serial No.: 09/499,592

Group Art Unit: 3713

Filed: February 07, 2000

Examiner: S.E. Jones

For: SLOT MACHINE HAVING MULTIPLE PROGRESSIVE JACKPOTS

TRANSMITTAL OF APPEAL BRIEF

Commissioner for Patents
Washington, DC 20231

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Sir:

Submitted herewith in triplicate is Appellant(s) Appeal Brief in support of the Notice of Appeal filed May 27, 2003. Please charge the Appeal Brief fee of \$320.00 to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Docket No.: 58977-026

#16 Appeal Brief
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PATENT

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APPEAL BRIEF

Commissioner for Patents
Washington, DC 20231

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 6, 2002.

I. REAL PARTY IN INTEREST

The real party in interest is SIGMA GAME, INC.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 23-92 are pending in this application. All claims have been finally rejected. It is from this final rejection that this appeal is taken.

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IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the final Office Action dated December 24, 2002. Hence, all amendments have been entered in this application.

V. SUMMARY OF INVENTION

The present invention is directed to a new form of game configured to entice a player to wager increasing amounts on individual games by providing multiple progressive jackpots. See, Abstract. A "progressive jackpot" is a jackpot that increases as a function of the number of past games played. For example, a slot machine having a progressive jackpot may have a jackpot of \$100 at the beginning of a day that will progressively increase, for example, by \$4 for every \$5 played. Accordingly, a winning player at the end of the day would receive a jackpot of \$200 assuming one-hundred-twenty-five \$1 bets were made in the meantime. After the win, the available jackpot would then be reset to a predetermined amount, e.g., \$50, that will again progressively increase with subsequent plays.

The present invention provides new forms of incentive to bet multiple amounts on individual games. For example, a player who wagers a **single coin** on a game can win a first progressive jackpot, assuming the player makes a winning combination. Further, if the player chooses to deposit **two coins** for a single game, the player can win a second (larger) progressive jackpot. Still further, if the player deposits **three coins** for a single game, the player has an opportunity to win a third (still larger) progressive jackpot. See, Fig. 2 and page 1, line 24 through page 2, line 5. The effect is to entice a player to wager greater amounts, e.g., three coins as opposed to a single coin, on individual games.

VI. ISSUES

A. The Rejections

1. Claims 23-46, 56, 57, 91 and 92 stand finally rejected under 35 U.S.C. § 112, first paragraph;
2. Claims 23-92 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Woods et al. (U.S. Patent No. 5,868,619).

B. The Issues

1. Whether claims 23-46, 56, 57, 91 and 92 are supported by the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed invention at the time the application was filed.
2. Whether claims 23-93 are anticipated by Woods et al. under 35 U.S.C. § 102(b).

VII. GROUPING OF CLAIMS

Claims 23-46 and 58-81 stand or fall together as a group. Claims 47-57 and 82-92 stand or fall together as a group.

VIII. THE ARGUMENTS

A. CLAIMS 23-46, 56, 57, 91 AND 92 ARE SUPPORTED BY THE SPECIFICATION

The Examiner's Position

According to the final Office Action of December 24, 2002, the Examiner contends that the specification does not support the limitation of "if [a] wager is a second wager amount, the second wager amount being larger than [a] first wager amount" as is recited in claims 23, 35, 56, 57, 70, 91

and 92. In fact, the Examiner contends that the specification "clearly indicates that the first and second wager amounts are equal in each embodiment in the specification."

Factual Error

The Examiner's contention is based on factual error. In fact, the specification provides at least **THREE examples** where the specification as originally filed supports the claim language at issue. That is, the specification provides multiple examples where different wager amounts (e.g. "coins") are available to a person using the claimed slot machine.

The First Example

The first example can be found at page 1, line 24 through page 2, line 5, reproduced below:

[A] **single coin** bet on a game entitles the player to win a first progressive jackpot ... If the player chooses to deposit **two coins** for a single game, the player can then win a second progressive jackpot ... If the player deposits **three coins** for a single game, the player has an opportunity to win a third progressive jackpot ..." {bolded emphasis added}

As is clearly shown by the above specification language, a player can choose to bet MULTIPLE wager amounts, i.e., a "**single coin**", "**two coins**" and "**three coins**".

Three coins is a larger amount than **two coins** or **one coin**.

Two coins is a larger amount than **one coin**.

Ergo, the Examiner's contention that "the first and second wager amounts are equal in each embodiment in the specification" is clearly in error **based on the plain language of the specification**.

That is, the plain and unequivocal language of the specification provides undeniable support that a player practicing the claimed invention can place bets of differing amounts.

The Second Example

The second example can be found at page 6, lines 9-16, reproduced below:

"In another embodiment, a **three coin** play activates the three paylines 34-36 and jackpot 1. An **additional three coins** doubles the awards as well as enables the winning of jackpot 2. An **additional three coins triples** the base awards and enables the winning of jackpot." {bolded emphasis added}

As is clearly shown by the above specification language, in this exemplary embodiment, a player can choose to bet MULTIPLE wager amounts, i.e., **three coins**, **six coins** and **nine coins**.

Nine coins is obviously a greater amount than **six coins** or **three coins**.

Six coins is obviously a greater amount than **three coins**.

Ergo, the plain language of the specification again directly contradicts the Examiner's contention that "the first and second wager amounts are equal in each embodiment in the specification". That is, the plain and unequivocal language of the specification again provides undeniable support that a player practicing the claimed invention can place bets of differing amounts.

The Third Example

The third example can be found in the flowchart of Fig. 2, a portion of which is reproduced below:

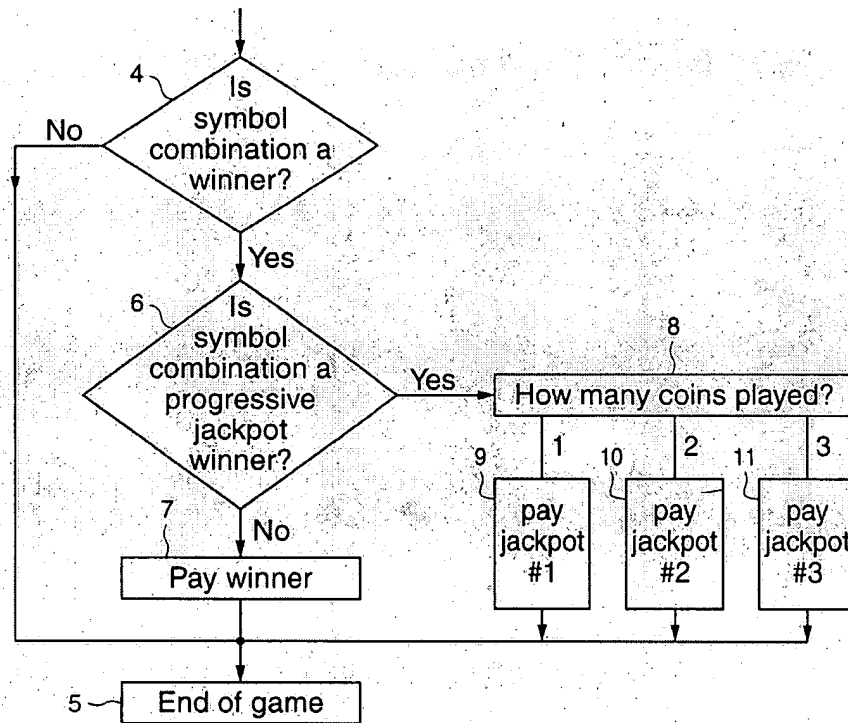


FIG. 2

As shown above, the flowchart of Fig. 2 includes a decision box 8 that monitors how many coins were played. The output of decision box 8 shows **three** wager amounts: **one coin, two coins** and **three coins**. A single coin option leads the process flow to step 9 ("pay jackpot #1"); a two coin option leads process flow to step 10 ("pay jackpot #2"); a third coin option leads process flow to step 11 ("pay jackpot #1"). That is, **three different wager amounts** will provide for **three different jackpot amounts**. Ergo, the plain and unequivocal language of the specification again provides undeniable support that a player practicing the claimed invention can place bets of differing amounts.

CONCLUSION

Based upon the foregoing, Appellants respectfully submit that the specification fully supports the claim language at issue under 35 U.S.C. § 112, first paragraph. Accordingly, Appellants submit that the imposed rejection under 35 U.S.C. § 112, first paragraph, is not factually or legally viable and should therefore be withdrawn.

B. WOODS ET AL. DOES NOT ANTICIPATE CLAIMS 23-46 AND 58-81

Summary of Argument

Independent claims 23, 35, 58 and 70 are independent claims having various commonly recited limitations. Claim 23 is presented below:

23. A gaming method, comprising the acts of:

providing a first progressive jackpot and a second progressive jackpot for a gaming system;

receiving a wager in the gaming system;

providing a random gaming result in the gaming system;

paying the **first progressive jackpot** if the random gaming result is a winning progressive jackpot result and if the wager is at least a **first wager amount**; and

paying the **second progressive jackpot** if the random gaming result is the winning progressive jackpot result and if the wager is at least a **second wager amount**, the second wager amount being larger than the first wager amount.

The burden of proving lack of novelty under 35 USC §102 is not met unless **every** limitation of the claimed invention is **identically** disclosed in a single reference. Accordingly, Applicants urge that

Woods does not identically disclose at least the limitation of paying a **first progressive jackpot** ... if a wager is at least a **first wager amount**, and paying a **second progressive jackpot** ... if the wager is at least a (larger) **second wager amount**, as recited in independent claim 23, and similarly recited in independent claims 35, 58 and 70.

Woods et al.

Woods discloses a method for playing a poker game that can be played as a table game or in the form of a slot-machine type apparatus. See, Abstract and Figs. 1-4B. The underlying strategy of the Woods game is to provide a player an opportunity to simultaneously play multiple poker hands and win various jackpots based on the outcomes of the poker hands. See, col. 2, lines 44-52 and Table 1. The Woods game is formed such that a dealer (or slot machine) can accept multiple wager amounts, e.g., bets in five dollar increments, to play five different hands. See, col. 3, lines 35-39.

In a particular embodiment, the Woods game can accept a "bonus wager" in order to receive payoffs for different card combinations among a player's five hands. See Table 1. For example, if a player makes a royal flush or a four-of-a-kind, a standard betting amount would reward the player for each hand independently. However, the bonus wager would allow the player to receive an extra amount based on the combination of a royal flush and a four-of-a-kind. See, col. 4, lines 23+.

Factual Error

The Examiner's rejection is prefaced on the erroneous assumption that Woods' progressive jackpots are identically situated with respect to different wagering amounts as the claimed invention. However, in contrast to the claimed invention, which recites the limitation of multiple progressive jackpots based on different wager amounts, **Woods discloses only payment of multiple progressive**

jackpots based on differing combinations of poker hand outcomes, not differing wager amounts.

See column 8, lines 43-58. That is, while Woods does disclose a progressive jackpot payout system based on a **poker hand outcomes**, Woods fails to identically disclose any form of multiple progressive jackpots based on differing wagering amounts. For instance, as is recited in col. 8, lines 49-54 of Woods, reproduced below:

For example, [a] progressive jackpot could be offered for a player who obtains two royal flushes or a royal flush and four-of-a-kind or any like combination.
Multiple progressive jackpots may be assembled for differing combinations.
(bolded emphasis added)

The type of "multiple progressive jackpots" disclosed in Woods are obviously dependent on differing combinations of poker hands, not differing wager amounts.

While Woods does disclose at col. 4, lines 58-62 that a "separate bonus wager" may be required for a player to participate in a "sub-hand combination jackpot" in order to assemble progressive jackpots for various poker combinations, this passage (the only passage in Woods that remotely discusses a separate/different wager amount) provides no support to a claim that Woods discloses paying a first progressive jackpot if the wager is a first wager amount and paying a second progressive jackpot if the wager is a second wager amount. **That is, the "separate bonus wager" of Woods only refers to a single wager amount that can provide for an opportunity to win progressive jackpots, but the progressive jackpots themselves are based solely on poker combinations.**

While the December 24, 2002 final Office Action states that the "noted limitations [regarding multiple progressive jackpots based on wager amounts] are not supported by Applicant's (sic) specification", as the ONLY basis for maintaining the 35 U.S.C. § 102 rejection (see page 3, "Response to Arguments" section of the final Office Action), this response is problematic for two reasons.

First, the Examiner's remarks are directed to issues arising under 35 U.S.C. § 112, first paragraph, not 35 U.S.C. § 102.

Second, the Examiner's remarks are not responsive to the Applicants' assertions that Woods fails to identically disclose the limitations at issue. As Applicants have demonstrated (with specific examples) that the specification provides numerous enabling examples of under 35 U.S.C. § 112, first paragraph, the Examiner's remarks are clearly non-responsive as the Examiner did not even respond to the issues under 35 U.S.C. § 112, first paragraph.

Accordingly, as Applicants have provided clear and uncontested evidence that Woods does not identically disclose the claimed invention as recited in independent claims 23, 35, 58 and 70 as well as dependent claims 56, 57, 91 and 92, no rejection under 35 USC §102 can be maintained of these claims and the claims which depend therefrom. That is, the burden of proving lack of novelty under 35 USC §102 has not been met since **every** limitation of the claimed invention is not **identically** disclosed in a single reference.

CONCLUSION

Based upon the foregoing, Appellants respectfully submit that the rejection under 35 U.S.C. § 102 cannot be maintained as the Examiner has failed to provide the requisite passages to support his assertions of identical disclosure, because the Examiner's assertions are factually flawed and because the Examiner's support of his assertions is based on an issue under 35 U.S.C. § 112, first paragraph, not 35 U.S.C. § 102. Accordingly, Appellants submit that the imposed rejection under 35 U.S.C. § 102, first paragraph, is not factually or legally viable.

C. WOODS ET AL. DOES NOT ANTICIPATE CLAIMS 47-57 AND 82-92

Summary of Argument

Independent claims 47 and 82 are independent claims having commonly recited limitations.

Claim 47 is presented below:

47. A gaming method, comprising the acts of:

providing a first progressive jackpot and a second progressive jackpot for a gaming system;

receiving a wager in the gaming system;

providing a random gaming result in the gaming system; and

paying the largest of either the first progressive jackpot or the second progressive jackpot if the random gaming result is a winning progressive jackpot result.

The burden of proving lack of novelty under 35 USC §102 is not met unless **every** limitation of the claimed invention is **identically** disclosed in a single reference. Accordingly, Applicants urge that Woods does not identically disclose at least the limitation of paying the largest of either the first progressive jackpot or the second progressive jackpot if the random gaming result is a winning progressive jackpot result, as recited in independent claim 47, and similarly recited in independent claim 82.

Factual Error

The Examiner's rejection is prefaced on the erroneous assumption that Woods' progressive jackpots are identically situated with respect to the claimed limitation of paying the largest of either a first progressive jackpot or a second progressive jackpot if a random gaming result is a winning progressive jackpot result. In contrast to the claimed invention, **Woods discloses no such feature.**

To the contrary, as discussed above, the different progressive jackpots of Woods only get paid based on the outcome of poker combinations. See column 8, lines 43-58. Within Woods, for any particular poker result, there is only one progressive jackpot amount paid out for different combinations of cards. This is in direct contrast to claims 47 and 82, which require paying out the larger of two different progressive jackpots for a particular "random gaming result."

Applicants respectfully note that the Examiner has not provided a SINGLE passage in support that Woods identically discloses paying the larger of either a first progressive jackpot or a second progressive jackpot if a random gaming result is a winning progressive jackpot result, but again relies on issues arising under 35 USC §112. Accordingly, Applicants urge that the Examiner has failed to provide the requisite factual support for a rejection under 35 USC §102.

CONCLUSION

Based upon the foregoing, Appellants respectfully submit that the rejection under 35 U.S.C. § 102 cannot be maintained as the Examiner has failed to provide the requisite passages to support his assertions of identical disclosure, because the Examiner's assertions are factually flawed and because the Examiner's support of his assertions is based on an issue under 35 U.S.C. § 112, first paragraph, not 35 U.S.C. § 102. Accordingly, Appellants submit that the imposed rejection under 35 U.S.C. § 102, first paragraph, is not factually or legally viable.

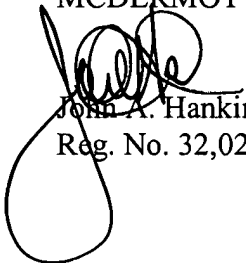
IX. PRAYER FOR RELIEF

For the reasons asserted *supra*, Appellants submit that the Examiner's rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 102 are factually and legally flawed. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections.

To the extent necessary, a Petition for an Extension of Time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of the paper, including the extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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